

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD O. GARDNER

Appeal No. 2004-2225
Application No. 08/896,514

HEARD: NOVEMBER 17, 2004



Before COHEN, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

We note, at the outset, that the application file presented to this panel is a reconstructed¹ file replacing the original file which has apparently been misplaced in the United States Patent and Trademark Office (USPTO). Inasmuch as the paper numbers assigned to each paper on the file jacket of the

¹ The file has been reconstructed from papers submitted by appellant from appellant's files.

reconstructed file do not correspond to the paper numbers on the papers themselves, we cannot be certain that the file wrapper before us accurately and fully represents the actual application file.

On or about January 4, 2001, appellant filed an appeal brief with an affidavit of Philip C. Malte appended thereto. In response to that brief, the examiner re-opened prosecution with a new non-final rejection mailed December 3, 2002. The examiner did not refer to or acknowledge the Malte affidavit in this non-final rejection.

On or about February 24, 2003, appellant responded to the non-final Office action of December 3, 2002 with a request for reinstatement of the appeal and a SECOND SUPPLEMENTAL BRIEF ON APPEAL, with the Malte affidavit appended thereto. In response to notification by the examiner that the SECOND SUPPLEMENTAL BRIEF ON APPEAL was defective, appellant filed a SUBSTITUTE SECOND SUPPLEMENTAL BRIEF ON APPEAL on or about December 3, 2003, with a copy of the Malte affidavit appended thereto. Appellant refers to the Malte declaration on page 8 of the SECOND SUPPLEMENTAL BRIEF ON APPEAL and on page 9 of the SUBSTITUTE

SECOND SUPPLEMENTAL BRIEF ON APPEAL, thereby indicating appellant's intent to rely on the Malte affidavit in this appeal.

An examiner's answer responsive to the brief and two supplemental briefs was mailed on March 3, 2004.² The answer makes no mention of the Malte affidavit, which appears to be directed to the rejections based on the Ellers patent.³ After reviewing appellant's disclosure and claims and the positions of both the examiner and appellant, this panel has decided that it would not be prudent to decide this appeal without the benefit of the examiner's indication as to whether the Malte affidavit has

² The examiner refers to an amendment filed December 3, 2003 on the first page of the answer and explains that this amendment is proper to place the claims in the form presented in the appendix of the SECOND SUPPLEMENTAL BRIEF ON APPEAL filed February 24, 2003. We cannot find an amendment filed December 3, 2003 in the reconstructed file. Thus, it is not clear whether this paper is missing or whether the examiner treated the SUBSTITUTE SECOND SUPPLEMENTAL BRIEF ON APPEAL as an amendment. In any event, both the examiner and appellant appear to be in agreement that the claims in the appendices of the two supplemental briefs are the claims on appeal.

³ U.S. Pat. No. 4,923,025, issued May 8, 1990.

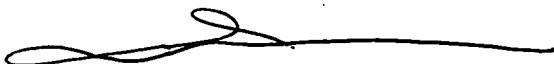
been entered and considered and, if entered and considered, the examiner's comments with regard thereto. We thus remand this application to the examiner to clarify the status of the Malte affidavit and, if it has been entered, to comment on its relevance with respect to the rejections based on the Ellers patent and explain why it is insufficient to overcome the rejection, as requested by appellant on page 1 of the REPLY BRIEF filed May 3, 2004.

CONCLUSION

This application is remanded to the examiner to take appropriate action with regard to the issues noted above.

This application, by virtue of its "special" status, requires immediate action. MPEP § 708.01. Further, it is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal.

REMANDED


IRWIN CHARLES COHEN)
Administrative Patent Judge)
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LAWRENCE J. STAAB)
Administrative Patent Judge)
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JENNIFER D. BAHR)
Administrative Patent Judge)
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